

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

FEB 23 2000

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ROBERT FILEPP,
KENNETH H. APPLEMAN,
ALEXANDER W. BIDWELL,
ALLAN M. WOLF,
JAMES A. GALAMBOS,
MEL BELLAR and
SAM MEO

Appeal No. 1997-0782
Application 08/158,029

Received

MAR 01 2000

**Director's Office
Group 2700**

ON BRIEF

Before THOMAS, BARRETT, and LALL, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 15, which constitute all the claims in the application.

Representative claim 1 is reproduced below:

1. A method of searching for and retrieving records included in a database provided in a computer network, the network having a plurality of reception systems at which respective users can request and retrieve respective records, the method comprising the steps of:

a. providing record locators indexed to record identifiers for the respective database records;

b. arranging multiple locators and respective indexed identifiers in plurality of groups, the groups respectively establishing predetermined subset searches of the database records;

c. assigning code designations to the respective locator groups;

d. generating a locator group code designation in response to a request for a record so that a group of record locators may be provided at the reception system and so that a locator may be selected which enables identification and retrieval of the record.

The following reference is relied upon by the examiner:

Cichelli et al. (Cichelli) 4,429,385 Jan. 31, 1984

Claims 1 through 15 stand rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite. Claims 1 through 15 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by Cichelli.

Rather than repeat the positions of the appellants and the examiner, reference is made to the briefs and the answers for the respective details thereof.

OPINION

Turning first to the rejection of claims 1 through 15 under the second paragraph of 35 U.S.C. § 112, it is to be noted that to comply with the requirements of the cited paragraph, a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure and the teachings of the prior art as it would be by the artisan. Note In re Johnson, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

We have reviewed and considered the examiner's reasons in support of the rejection, but are not convinced that the cited claims fail to comply with the second paragraph of 35 U.S.C. § 112. At the outset, we note that the breadth of the claims is not equated with indefiniteness of the claims. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971). It is perfectly permissible for appellant to claim his invention in terms as broad as his application disclosure will support.

Many of those problems set forth in the answer with respect to certain identified claims appear to have been obviated by the examiner's subsequent entry of the amendment after final rejection, yet the supplemental examiner's answer fails to

Appeal No. 1997-0782
Application 08/158,029

withdraw the rejection as to any of the claims 1 to 15. Many of the examiner's reasons set forth in the examiner's answer are not clearly understood, at least from an artisan's perspective, when viewing the claimed invention in light of the specification as the above noted precedent requires. The terminology in the claims has been defined in the specification, and since the claims are consistent with the specification, it can hardly be said that the claims are therefore indefinite. To the extent the examiner's real problem is the breadth of the language of certain features of the claims, it has already been noted that breadth is not equal to indefiniteness. In any event, many of the problems of the claims outlined by the examiner have been correlated in the brief to the portions of the specification which explain in detail the features. We read them that way and we believe that the artisan would as well. Reading certain limitations in light of the specification is not equivalent to reading into the claim limitations from the specification. The claims reasonably define the invention disclosed. Therefore, for all these reasons, the rejection of claims 1 through 15 under the second paragraph of 35 U.S.C. § 112 is reversed.

Turning lastly to the rejection of claims 1 through 15 under 35 U.S.C. § 102(b) as being anticipated by Cichelli, we also reverse this rejection. Cichelli's invention is a sophisticated Teletext system which essentially broadcasts one-way to the various receivers information from the head end system of Figure 1. There is a repetitive transmission of this information from this head end system to each receiver which enables the user there to select which portions of that continually recurring one-way data message the user desires. Thus, there is no true interactive nature as this term is conventionally used in the art in the Cichelli system. In this respect, we are in agreement with appellants' position set forth in the brief and reply brief.

This interactive nature is set forth in the preamble of representative independent claim 11 on appeal per se. Overall, the method in this claim calls for searching for and retrieving application data including records in an interactive service database stored in a computer network by the user entering certain data at variously defined reception systems. These users

Appeal No. 1997-0782
Application 08/158,029

request and retrieve this record information from this database selectively. The body of claim 11 even recites that table code designations are generated in response to a query entered at the reception system or user's terminal. The last clause of this claim permits the user to retrieve at his terminal requested applications information based on these queries, where these applications have been defined as being in the interactive service database stored in a computer network in the preamble.

Similar conclusions can be reached with respect to the subject matter of independent claim 1 on appeal, which again recites a method for searching for and retrieving records included in a database provided in a computer network, where there are attached plural reception systems at which the users request and retrieve these records. The body of the claim therefore sets forth certain details as to how this occurs. The final step of claim 1 permits the user at a reception system to request (or query as in claim 11) a record defined in the preamble of the claim as being associated with the records located in the database of the computer network in the preamble.

Appeal No. 1997-0782
Application 08/158,029

Unlike independent claim 11, claim 1 does not per se use the word interactive, but the same sense is conveyed overall to the subject matter recited in claim 1.

Therefore, whatever teachings or suggestions the examiner has relied upon in the rejection based on the features of Cichelli can- not be correlated in a sustainable rejection within the limited confines of 35 U.S.C. § 102 because of the lack of a true interactive environment in Cichelli.

Finally, we observe that appellants' submission of prior art as Paper No. 3 on November 2, 1994, apparently has not been acknowledged or responded to by the examiner in any subsequent paper. The identification of the existence of this separately submitted prior art information statement was not a part of the amendment filed on the same date but was mentioned only in its cover letter and does not have associated with it a traditional Patent Office form 1449. This appears to be an inadvertent oversight by the examiner.

In view of the foregoing, the decision of the examiner rejecting claims 1 through 15 under the second paragraph of 35 U.S.C. § 112 is reversed as is the separate rejection of these

[illegible]

REVERSED

Parshotam S. Lall
Parshotam S. Lall
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

8

Appeal No. 1997-0782
Application 08/158,029

Paul C. Scifo, Esq.
10 Lee Court
Franklin Square, NY 11010

[illegible]